

IV. AMENDMENTS TO THE DRAWINGS

- THE DRAWINGS OF THE PATENT IS HEREBY AMENDED AS SET FORTH BELOW:
 - *There are no amendments to the drawings.*

V. REMARKS/ARGUMENTS

- STATUS OF CLAIMS

Claims 20 to 27 are pending. Claims 1 to 19 and 28 – 31 are canceled, without prejudice.

- CLAIM OBJECTIONS

- Examiner's Stance

The Examiner has objected to claims 20 through 27 for informalities. Specifically, claim 20 incorporates the term *hot short* unnecessarily in quotation marks followed by a definition in parenthesis. Claims 21 through 27 depend from claim 20.

- Applicant's Response

The Applicant has amended claim 20 to remove the parenthesis and parenthesized definition.

- CLAIM REJECTIONS

- REJECTIONS UNDER 35 U.S.C. §103(a)

- Examiner's Stance

In the previous Office Action, the Examiner has rejected claims 20 through 27, under 35 U.S.C. §103(a), as being obvious in view of WO 02/095082, GB 2355990, or U.S. 6,726,877 to Eccles (hereafter referred to as Eccles). Specifically, the Examiner states that WO 02/095082 discloses the same Ag alloy (page 1, lines 25-29 and page 11, lines 29-31). The Examiner further alleges that GB 2355990 discloses another claimed Ag alloy (page 2, lines 8-16 and page 4, lines 20-23). And, in addition, the Examiner alleges that Eccles discloses another claimed alloy (col. 1; line 27 and col 2, lines 55-65). The Examiner states that the prior art compounds bracket the Applicant's claimed compounds and that obviousness typically exists when ranges of a claimed composition overlap the ranges disclosed in prior art.

- Applicants' Response

The Applicant respectfully traverses the rejection of claims 20 through 27 under 35 U.S.C. 103.

Applicant notes that the basis for factual inquires, with respect to findings of obviousness under 35 U.S.C. 103, are set forth in accordance with *Graham v. John Deere Co.*, 383 U.S. 1, 148 U.S.P.Q. 459 (1966), the primary indicia being summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or non-obviousness.

The Applicant calls the Examiner's attention to MPEP 2143.03, which states that to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.

The limitations of independent claim 1 include, in part:

"[A]n alloy consisting essentially of from 93.5 wt% to 95.5 wt% Ag, from 1.0 wt% to 2 wt% Ge, 1-40 ppm of B, optionally 0.5 wt % of any of Zn, Cd, and Sn, and optionally 0.1-1 wt % Si, and the remainder, apart from impurities, being copper..." [Instant claim 20]

Specifically, the Ge content is limited to the range of 1.0% to 2.0% by weight which gives specific features to the claimed alloy. As stated in the subject specification:

"[A]s regards Ge, contents of from 1.0 to 2.0 wt % are preferred. Below 1.0 wt % Ge, consistent resistance to firestain and tarnish may not be obtained, whereas above 2 wt % Ge there is an increasing risk of embrittlement of the alloy..." [Instant claim 20; para.[0019]]

None of the references cited discuss this precise range of Ge and the benefit of including this range in an alloy. Further, there is no mention of this range of Ge concentration in combination with the range of Ag specified by the limitations of claim 20.

The Applicant also respectfully continues to assert the non-obviousness of claims 20 through 27 on the basis of the previously presented Response to Office Action, dated April 7, 2008.

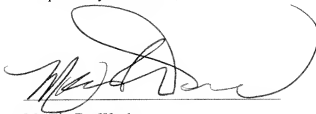
Applicant respectfully asserts that instant independent claim is nonobvious and is therefore allowable. Instant dependent claims 21 through 27 depend from instant independent claim 20. In accordance with MPEP 2143.03, if an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. Claims 21 through 27, at least for this reason, are also allowable.

CONCLUSION TO REMARKS

Applicant asserts that this response is fully responsive to the FINAL OFFICE ACTION OF AUGUST 14, 2008. In view of the above, it is respectfully submitted that the subject matter of the pending claims is patentable over the references cited. Applicant respectfully seeks early allowance of the pending claims.

Dated: February 4, 2009

Respectfully Submitted,

A handwritten signature in black ink, appearing to read 'Marvin R. Wachs', written over a horizontal line.

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VI. APPENDIX

- *No appendix is intended to be attached*